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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,143	04/18/2006	Kohji Masuda	286268US8PCT	5649
22850	7590	04/03/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WINKLER, MELISSA A	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			04/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/576,143	Applicant(s) MASUDA ET AL.	
	Examiner MELISSA WINKLER	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/18/06 and 4/4/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 - 15 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2003/0068466 to Mimura et al.

Regarding Claims 1 - 15. Mimura et al. teach a thermoplastic resin film that is foamed and shaped into a sheet (Paragraphs 9, 12, and 13). The thermoplastic resin is preferably a polyester (Paragraph 9). The film may contain inorganic fine particles, such as zinc oxide, most preferably in an amount of 3 to 20 weight percent (Paragraph 15). The cross-sectional area of the voids/bubbles is indicated to more preferably fall in the range of 1 to 30 μm^2 , based upon the circular or ovular cross-sectional profile of the voids (Paragraph 13).

Mimura et al. teach the voids may be formed by adding carbon dioxide to the resin during or after its extrusion (Paragraph 12). While Mimura et al. do not teach the resin sheet is held in a pressurized inert gas atmosphere and then heated under normal

pressure to obtain a foamed resin, these are product-by-process limitations that are not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695,698, 227 USPQ 964, 966 (Fed. Cir. 1985) (MPEP 2113) Once a product appearing substantially identical is found, the burden shifts to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993) (MPEP 2113)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7, 10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2004-059608 to Nishikawa et al. Citations for this document are taken from the English-language abstract provided by applicant.

Regarding Claims 1, 2, 4, 5, 7, 10, 12, and 14. Nishikawa et al. teach a polyester foamed sheet comprising titanium oxide in an amount of 0.5 – 25 parts by weight based on 100 parts by weight polyester ("Solution", Lines 1 – 3).

Applicant claims fine pores with a bubble diameter of 10 μm or less, while Nishikawa et al. indicate the cells/bubbles have an average cell diameter in the range of 1 to 300 μm ("Solution", Lines 3 - 4). However, it has been held that where the claimed ranges overlap or lie inside ranges disclosed by the prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976) (MPEP 2144.05)

While Nishikawa et al. do not teach the resin sheet is held in a pressurized inert gas atmosphere and then heated under normal pressure to obtain a foamed resin, these are product-by-process limitations that are not further limiting in as so far as the structure of the product is concerned. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from

a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695,698, 227 USPQ 964, 966 (Fed. Cir. 1985) (MPEP 2113) Once a product appearing substantially identical is found, the burden shifts to the applicant to show an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1993) (MPEP 2113)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van*

Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 - 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 4, and 7 of copending Application No. 11/571,662 in view of US 2003/0068466 to Mimura et al.

This is a provisional obviousness-type double patenting rejection.

Regarding Claims 1 – 15. Instant Claims 1 – 15 correspond to combinations of Claims 1, 4, and 7 of Application No. 11/571,662. Though Application No. 11/571,662 does not teach adding zinc oxide in the claimed amount, these limitations are taught by Mimura et al. (Paragraph 15). At the time of invention, it would have been obvious to a person of ordinary skill in the art to add zinc oxide in the amount taught by Mimura et

al. to the foam in Application No. 11/571,662. The motivation would have been that zinc oxide in this amount acts as a nucleating agent in the foam composition (Mimura et al.: Paragraph 15), as well as a white pigment.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA WINKLER whose telephone number is (571)270-3305. The examiner can normally be reached on Monday - Friday 7:30AM - 5PM E.S.T..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

MW
March 25, 2008